

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(fraunh01.049)

5 **Applicant:** Luo, et al. **Confirmation no:** 9357

Application No: 10/526,843 **Group Art Unit:** 2135

Filed: 3/3/2005 **Examiner:** Gyorfi, Thomas A.

10 **Title:** *Protecting mobile code against malicious hosts*

15 Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Background

Prosecution of the PCT application

20 The above application is the U.S. National Phase of PCT/US03/27693, which received a *Written Opinion* under PCT Rule 66 mailed May 28, 2004. In the *Written Opinion*, the IPEA/US examiner found that dependent claims 5, 11-13, 19-21, and 27-29 fulfilled the requirements of PCT Article 33(2 and 3) and that claims 1-4, 6-10, 14-18 and 22-26 did not fulfill the requirements of PCT Article 33(2 and 3) because the limitations of the

25 claims were completely disclosed in the reference Monden et al, *Watermarking Java Programs*, published 1999 and the substantially similar reference Monden et al., *A practical method for watermarking Java programs*, published in 2000 by the IEEE as 0-7695-0792-1, termed hereinafter "Monden", completely disclose what is claimed in those claims.

30 Applicants responded to the *Written Opinion* on 7/23/2004 with a traversal of the rejections of claims 1-4, 6-10, 14-18, and 22-26. The traversal made two points:

- Monden contains substantially no disclosure of the limitations of Applicants' independent claims which appear in the following form in claim 1:

35 one or more obfuscated names that correspond to
 system symbolic names;

a first association between the obfuscated names and encrypted forms of the corresponding system symbolic names; ...

5 the execution environment including a second association of the encrypted forms with information needed to resolve the corresponding system symbolic names, using the first and second associations to resolve the obfuscated names, ...

- Monden's static watermarking is done to provide an identification of the owner of
10 the code, not to determine whether the code being executed has been modified either on the way to the system that is executing it or with the system that is executing it.

The first Office action in the US application

15 The above application entered the U.S. national phase on 3/3/2005. Examiner mailed a first Office action in the application on 04/04/2008 in which he rejected claims 1-5 and 22-29 under 35 U.S.C. 101 as addressed to "software *per se*" and consequently as not addressed to patentable subject matter. Examiner further rejected claims 1-29 under 35 U.S.C. 103 as anticipated by Monden, *supra*, in combination with Valdez, et al., *Software*
20 *Disengineering: Program Hiding Architecture and Experiments*, IH 99, A Pitman, (Ed.): IH'99, LNCS 1768, pp. 379, 394, Berlin, Heidelberg, 2000 (henceforth "Valdez"). Applicants have amended claims 1-5 and 2-29 to overcome the rejection under 35 U.S.C 101, have amended claim 1 to more clearly distinguish it from Monden, and are traversing the rejection of claims 1-29 under 35 U.S.C 103. Applicants are further
25 correcting an error in the title as listed in the filing receipt.

Please amend the claims as follows: